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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,979	03/22/2001	Gary de Jong	24601-416	7635
20985	7590	09/29/2006	EXAMINER	
FISH & RICHARDSON, PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			SULLIVAN, DANIEL M	
			ART UNIT	PAPER NUMBER
			1636	

DATE MAILED: 09/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,979

Applicant(s)

DE JONG ET AL.

Examiner

Daniel M. Sullivan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-32,34-47,59,61-64 and 144-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-25,27-32,35-47 and 144-146 is/are allowed.
- 6) ☒ Claim(s) 59,61-64 and 147 is/are rejected.
- 7) ☒ Claim(s) 26 and 34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/03,7/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 July 2006 has been entered.

This Office Action is a reply to the Paper filed 17 July 2006 in response to the Final Office action mailed 10 March 2006. Claims 1, 3-32, 34-47, 59, 61-64 and 144-147 were considered in the 10 March Office Action. Claim 1 was amended in the 17 July Paper. Claims 1, 3-32, 34-47, 59, 61-64 and 144-147 are pending and under consideration.

Response to Amendment and Arguments

Claim Rejections - 35 USC § 102

Rejection of claims 1, 3, 4, 6, 7, 9, 10, 12-14 and 30-32 under 35 U.S.C. 102(b) as being anticipated by Marschall *et al.* (1999) *Gene Ther.* 6:1634-1637 as evidenced by Lipofectamine™ Reagent product description, available from Invitrogen™ life technologies or Transfectam™ Reagent product description, is **withdrawn** in view of the amendment of claim 1 such that the method is limited to applying a second delivery agent that enhances permeability of the cell to the nucleic acid molecule.

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Claim Rejections - 35 USC § 103

Rejection of claims 1-11, 12-14, 30-32 and 144-146 under 35 U.S.C. 103(a) as being unpatentable over Hadlaczky *et al.* (2/2000) US Patent No. 6,025,155 in view of Marschall *et al.* as evidenced by Lipofectamine™ Reagent product description or Transfectam™ Reagent product description is **withdrawn** in view of the amendment of claim 1 such that the method is limited to applying a second delivery agent that enhances permeability of the cell to the nucleic acid molecule.

Claims 59, 61-64 and 147 **stand rejected** under 35 U.S.C. 103(a) as being unpatentable over Hadlaczky *et al.* (2/2000) US Patent No. 6,025,155 in view of Marschall *et al.* as evidenced by Lipofectamine™ Reagent product description (*supra*) or Transfectam™ Reagent product description (*supra*) for the reasons set forth at pages 8-10 of the 11 April 2005 Office Action (see especially the paragraph bridging pp. 9-10). Applicant's argues at p. 14 of the 17 July Paper that the art does not teach or suggest a method in which nucleic acid molecules are treated with a first delivery agent that increases contact between the nucleic acid molecules and the cells and cells are treated with a second, different reagent, that increases permeability of the cells. This argument has been fully considered but the art does, in fact, teach a method wherein nucleic acid molecules are treated with a first delivery agent and the rejected claims are not limited to treating cells with a second agent that increases permeability of the cells. Therefore, for the reasons of record, the claimed invention as a whole is obvious over the art and the claims stand properly rejected under 35 USC §103(a).

New Grounds

Claim Objections

Claims 26 and 34 are objected to because of the following informalities:

Claim 26, part (b), lines 2 and 3 recite “the nucleic acid molecule”, which appears to rely on “the large nucleic acid molecule” recited in the preamble for support. In the interest of clarity, it would be preferable that the recitations of “the nucleic acid molecule” recite, “the large nucleic acid molecule” to clarify that the nucleic acid molecule referred to is the large nucleic acid molecule recited in the preamble.

Claim 34 is objected to because the phrase “adding a delivery agent to composition containing...” recited in part (a) is grammatically incorrect. Amending the claim to insert the indefinite article “a” between “to” and “composition” would be remedial.

Appropriate correction is required.

Allowable Subject Matter

Claims 1, 3-25, 27-32, 35-47 and 144-146 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel M. Sullivan whose telephone number is 571-272-0779. The examiner can normally be reached on Monday through Friday 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Remy Yucel, Ph.D. can be reached on 571-272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) (<http://pair-direct.uspto.gov>) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Daniel M. Sullivan, Ph.D.

Primary Examiner

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